PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:	Confirmation Number: 2881
Christelle PRAGNON et al.	Attorney Docket Number: 021305-00214
Serial Number: 10/539,406	Group Art Unit: 1657
Filed: November 23, 2005	Examiner: Paul C. Martin

For: METHOD FOR ANALYZING TUMOR AGGRESSIVITY COMPRISING MEASUREMENT OF POLYMERIZED ACTIN

PETITION UNDER 37 C.F.R. § 1.181
INVOKING SUPERVISORY AUTHORITY
FOR REFUSAL TO ENTER AN AMENDMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Date: July 14, 2008

Sir:

Pursuant to the provisions of 37 C.F.R. § 1.181, Applicants hereby Petition to invoke the supervisory authority of the Director.

Issue Being Petitioned

Applicants' January 8, 2008 Amendment is being improperly being denied entry by the Examiner in charge of the above-referenced application. As explained in Applicants' Response to Notice of Non-Responsive Amendment filed on April 11, 2008, which was also apparently deemed non-responsive, Applicants have provided a full and complete response to the rejections set forth in the Office Action dated August 8, 2007.

Applicants respectfully request relief from the Examiner's unwarranted refusal to resume prosecution of this application.

Statement of the Facts Involved

Applicants filed an Amendment After Final Rejection on November 8, 2007 in response to the final Office Action dated August 8, 2007.

This Amendment After Final Rejection was entered and considered, and an Advisory Action was issued on December 4, 2007 that indicated as much. The comments provided with the Advisory Action stated that the rejections under 35 U.S.C. § 112, first and second paragraphs, were being maintained for the reasons of record. The Advisory Action did not allege that Applicants' amendments and remarks regarding these rejections were not responsive, only that they were not persuasive.

On January 8, 2008, Applicants submitted a ***further*** response to the August 8, 2007 Office Action along with an RCE and a Petition for Extension of Time. This Amendment Submitted with RCE was not a required submission. It was merely a supplemental amendment filed to make further claim amendments to enhance the value of the previously-submitted arguments in response to the prior art rejections. Applicants incorporated by reference the comments set forth in their fully-responsive November 8, 2007 Amendment After Final Rejection.

Applicants expected that because the November 8, 2007 response to the August 8, 2007 Office Action was entered, the supplemental response filed on January 8, 2008 would also be entered, as evidenced by the statement found on the first page of the Amendment Submitted with RCE, "***Further to*** the Amendment After Final Rejection filed on November 8, 2007, please amend the application as shown on the following pages," and the statement found in the Remarks section, "Applicants refer the Examiner to the remarks contained in the Amendments filed on May 17, 2007 and ***November 8, 2007***."

(Emphasis added.)

In the Notice dated March 14, 2008, the Amendment filed on January 8, 2008 was considered non-responsive for failing to address the rejection of claims 6-13 under 35 U.S.C. § 112, first paragraph, for alleged lack of written description, and the rejection of claims 8-11 under 35 U.S.C. § 112, second paragraph, for alleged indefiniteness.

This March 14, 2008 Notice was clearly issued in error, as the Amendment Submitted with RCE under 37 C.F.R. § 1.114 that was filed on January 8, 2008 was not the first or only submission in response to the Office Action dated August 8, 2007. Rather, the January 8, 2008 Amendment was ***supplemental to*** the Amendment After Final Rejection under 37 C.F.R. § 1.116 that was submitted on November 8, 2007, which was entered and considered by the Examiner. As noted above, it incorporated by reference all of Applicants' previous comments in response to those rejections.

Applicants filed a Response to Notice of Non-Responsive Amendment on April 11, 2008, which pointed out all of the above facts to the Examiner in charge of this application, to no avail.

On June 19, 2008, the Examiner issued a ***further*** Communication, again indicating that the Response filed on January 8, 2008 was not considered fully responsive. The Examiner indicated that "[s]ince the Advisory Action of 12/4/07 reaffirmed those rejections and answered the Applicant's arguments, the current amendment which does not further address those rejections or amend the claims is deemed to be non-responsive." However, this statement reveals that the Examiner is erroneously attempting to require Applicants to provide a full and complete response to the Advisory Action of December 4, 2007, as if it was itself an Office Action. There is

no obligation to provide a response to an Advisory Action under the facts of this situation, as has been well-established since RCE practice was initiated by the U.S. Patent Office. *See*, e.g., the AIPA RCE Questions and Answers FAQ found at www.uspto.gov/web/offices/dcom/olia/aipa/rcefaq.htm.[1]

Accordingly, Applicants are under no obligation to further amend the claims and/or provide new arguments in response to the Office Action mailed August 8, 2007, as a complete response to the rejections contained therein has already been submitted. Applicants are also not under any obligation to amend the claims and/or provide new arguments in response to the Advisory Action mailed December 4, 2007.

Applicants again assert that if the Examiner continues to take the position that the rejections under 35 U.S.C. § 112, first and second paragraphs, have not been overcome by the claim amendments and arguments presented in Applicants' November 8, 2007 and January 8, 2008 submissions, then ***the proper course of action is to point out the alleged deficiencies in Applicants' arguments and repeat the rejections in the next Office Action, not to refuse to allow Applicants the ability right to prosecute their application unless and until they capitulate to the Examiner's apparent demands that the rejected claims be cancelled.***

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[1] A7. What submission is required if applicant has submitted arguments after final which were (1) entered by the examiner (2) not found persuasive by the examiner in the prior prosecution and (3) an advisory action to that effect was mailed?

Prior to submitting the request for continued examination (and fee), the final rejection continues as modified by the advisory action. ***The request for continued examination (and fee) may be accompanied by new arguments or amendments. The request for continued examination, however, need not be accompanied by new arguments or amendments***. The fact that the previously submitted arguments were not found persuasive does not preclude them as a submission under 37 CFR 1.114, provided that such arguments are responsive within the meaning of 37 CFR 1.111 to the Office action. Consideration of whether any submission is responsive within the meaning of 37 CFR 1.111 to the last outstanding Office action is done without factoring in the "final" status of such outstanding Office action. Thus, a reply which might not be acceptable as a reply under 37 CFR 1.113 when the application is under a final rejection may very well be acceptable as a reply under 37 CFR 1.111.

Relief Requested

In conclusion, Applicants respectfully request that the January 8, 2008 submission be entered, and that prosecution be resumed in this application. Applicants also respectfully request an indication that the prior Communications dated March 14, 2008 and June 19, 2008 have been withdrawn, and issuance of an Office Action responsive to the amendments and remarks presented in the November 8, 2007 and January 8, 2008 submissions.

CONCLUSION

No fee is believed due consideration of this paper. However, the Commissioner is hereby authorized to charge any fee deficiency or credit any overpayment associated with this communication to Deposit Account No. 01-2300, **referencing attorney docket number 021305.00214**.

Respectfully submitted,

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